

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB  
Hearing:  
September 25, 1996

AUG 5, 97  
Paper No. 39  
EWH/TAF

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Pennington Enterprises, Inc.

v.

Monsanto Company, substituted for White Swan, Ltd.

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Cancellation No. 21,800

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James F. Vaughan of Hopkins & Thomas for Pennington  
Enterprises, Inc.

Mark I. Feldman of Rudnick & Wolfe for Monsanto Company,  
substituted for White Swan, Ltd.

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Before Cissel, Hanak and Hairston, Administrative  
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

In May 1993 Pennington Enterprises, Inc. (petitioner)  
filed a petition for cancellation of Registration No.

1,763,148 then owned by White Swan, Ltd. (registrant).<sup>1</sup> This registration issued on April 6, 1993 with a claimed first use date of August 1990. The mark of the registration is COLOR YOUR GARDEN depicted in typed capital letters, and the goods of the registration are "flower seeds."

Petitioner alleged in its cancellation petition that continuously since at least as early as March 22, 1990, petitioner had used the identical mark COLOR YOUR GARDEN in connection with the sale of flower seeds, and that registrant's use of the same mark for the same goods is likely to cause confusion, mistake or deception.

In its answer, registrant admitted that the use by registrant and petitioner of the identical mark for identical goods is likely to cause confusion, mistake or deception. However, registrant alleged that it, and not petitioner, was the first to use the mark COLOR YOUR GARDEN in connection with flower seeds. Registrant stated that the August 1990 first use date set forth in its Registration No.

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<sup>1</sup> Long after the conclusion of the trial in this case, and indeed long after all of the briefs were filed, Monsanto Company filed a motion to substitute itself for White Swan, Ltd. In its September 6, 1996 paper, Monsanto explained that on April 15, 1996, White Swan, Ltd. assigned to Monsanto Registration No. 1,763,148 which is the subject of this cancellation proceeding. Also in September 1996, Monsanto submitted a paper revoking "all previous powers of attorney with respect to U.S. Reg. No. 1,763,148," and Monsanto appointed Mark I. Feldman "to defend said registration." In a order dated September 17, 1996, this Board granted Monsanto's motion to substitute itself "as the party defendant in this case." Because all of the trial and briefing in this case took place while White Swan was the owner of Registration No. 1,763,148, we will, for ease of reference, use the term "registrant" to refer collectively to Monsanto and White Swan.

1,763,148 was incorrect, and that the correct date of first use should have been "on or about January 29, 1989."

The record in this case includes the depositions, with exhibits, of Richard Best (Senior Vice President of petitioner), Douglas Harper (Manager of Seed Production for petitioner), Harold Saltzman (Co-Chairman of White Swan), Ruth Saltzman (Co-Chairman of White Swan), Deborah Saltzman (President of White Swan) and Heidi Rickabaugh (an owner of a graphic design firm which did work for White Swan).

Both parties filed briefs. Petitioner requested an oral hearing which was held before this Board on September 25, 1996. Present at the hearing were counsel for petitioner Pennington Enterprises as well as counsel for now registrant Monsanto.

Before getting into the merits of this matter, one preliminary matter should be clarified. In its trial brief, then registrant White Swan requested that this Board reconsider its decision of April 4, 1994 denying registrant's motion for summary judgment. Registrant's summary judgment motion was based upon the Morehouse defense. Morehouse Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881, 160 USPQ 715 (CCPA 1969). As the Board explained at page 2 of its April 4, 1994 decision, the essence of registrant's Morehouse defense was "that petitioner cannot be damaged by registrant's involved registration [Registration No. 1,763,148] because registrant owns [unchallenged] Registration No. 1,735,781 for the mark COLOR

SCHEME GARDENING for flower seeds." The Board then rejected registrant's Morehouse defense by stating as follows at page 5 of its opinion: "The mark involved in registrant's challenged registration is not 'substantially identical' to that in registrant's unchallenged registration. That is, registrant's [unchallenged] mark, COLOR SCHEME GARDENING, obviously differs from registrant's [challenged] mark, COLOR YOUR GARDEN, in sound, appearance, meaning and commercial impression."

At the oral hearing held on September 25, 1996, counsel for registrant Monsanto stated that registrant Monsanto would no longer pursue the Morehouse defense. This concession is well taken because the aforementioned two marks are clearly not "substantially identical," and hence, one of the two requirements for the Morehouse defense is simply not met. See the cases cited in this Board's opinion of April 4, 1994 as well as 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 20:38 at pages 20-72 to 20-75 (4th ed. 1996).

We will now turn to the merits of this priority of use dispute. Petitioner has established that it first used the mark COLOR YOUR GARDEN on wild flower seeds in March 1990. (Best deposition page 13; Harper deposition page 23).

As previously noted, in its application to register COLOR YOUR GARDEN for flower seeds, registrant White Swan -- through Ruth Saltzman who was then identified as president of applicant White Swan -- stated that "the trademark

[COLOR YOUR GARDEN] was first used on the goods in August, 1990; was first used on the goods in interstate commerce in August, 1990; and is now [August 21, 1992] in use in such commerce." Mr. Harold Saltzman testified that sometime in the fall of 1992, he first learned of petitioner's use of the trademark COLOR YOUR GARDEN. (Harold Saltzman deposition page 6). Mr. Saltzman then sent on October 14, 1992 a letter via fax transmission to petitioner which reads, in its entirety, as follows:

It has recently come to my attention that you are using the trademark COLOR YOUR GARDEN in connection with flower seeds. White Swan has used the identical trademark COLOR YOUR GARDEN since August 1990 with seeds. There is enclosed a copy of a label showing our use of that trademark.

I trust that you wish to settle this matter on an amicable basis and would promptly agree to stop using COLOR YOUR GARDEN.

Please advise within 7 days how soon you will be able to stop using COLOR YOUR GARDEN.

Subsequently, Mr. Harold Saltzman received from petitioner a letter dated October 15, 1992 advising Mr. Saltzman that petitioner first used COLOR YOUR GARDEN for wild flower seeds prior to August 1990. There is nothing in the record to indicate that White Swan thereafter either challenged petitioner's earlier claimed date of first use, or asserted that White Swan itself had used COLOR YOUR GARDEN prior to August 1990.

As previously noted, Registration No. 1,763,148 issued on April 6, 1993. In May 1993 petitioner filed its petition

for cancellation of this registration. In August 1993, then registrant White Swan filed its answer to the petition for cancellation. In paragraph 6 of its answer, then registrant White Swan asserted for the very first time that it used COLOR YOUR GARDEN prior to the August 1990 first use date set forth in its application, and set forth again in its October 14, 1992 cease and desist letter to petitioner. Paragraph 6 of White Swan's answer reads as follows:

Registrant [White Swan] first used the mark COLOR YOUR GARDEN on flower seeds in interstate commerce on or about January 29, 1989. Commencing on or about January 29, 1989 at the New York Gift Show in New York City, registrant [White Swan] had a booth at which the trademark COLOR YOUR GARDEN was used in connection with a display of its flower seeds. This use has been valid and continuous since the date of first use in the United States, and has not been abandoned.

Thus, it was not until after petitioner brought its cancellation petition that then registrant White Swan first asserted a date of first use earlier than August 1990, the date of first use set forth not only in White Swan's application, but also in White Swan's cease and desist letter to petitioner.

When an applicant or registrant attempts to claim an earlier date of first use than set forth in its application, the law is well settled that the "applicant [or registrant] is under a heavy burden and his proof [of an earlier first use date] must be clear and convincing and must not be characterized but contradiction, inconsistencies and indefiniteness." George Putnam & Co., Inc. v. Hyro-

Dynamics, Inc., 228 USPQ 951, 952 (TTAB 1986), aff'd 1 USPQ2d 1772 (Fed. Cir. 1987). Our primary reviewing court has cogently explained the reason for this "heavy [evidentiary] burden" in the following manner: "The reason for such an increased evidentiary burden, supported by common sense, is that a change of position from one 'considered to have been made against interest at the time of filing of the application' ... requires enhanced substantiation." Hydro-Dynamics, 1 USPQ2d 1773-74.

In this case, there is an additional reason for placing on registrant a heavier burden of proving by clear and convincing evidence that it actually used COLOR YOUR GARDEN prior to August 1990. This additional reason is Mr. Saltzman's October 14, 1992 letter to petitioner where Mr. Saltzman again stated that registrant's first use date was August 1990. In essence, this October 14, 1992 letter is yet another admission against interest, an admission very similar to that found in the application itself. See Lasek & Miller Associates v. Rubin, 201 USPQ2d 831, 838 (TTAB 1978)("The only credible explanation for Mr. Rubin's 180 degree change of direction is that he suddenly found himself confronted by a situation where his presumed prior rights had evaporated. ... However, the factual statements made in the letter may be taken as admissions and respondents' earlier opinion may be received in evidence..."). See also 4 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 32:109 at page 32-132 (4th ed. 1996).

It is against this body of law that we review registrant's evidence to see if it is clear and convincing, or if it is characterized by indefiniteness and the like. To cut to the point, we find that not only is registrant's evidence not clear and convincing, but rather it is quite vague. Moreover, we note that registrant has absolutely no written documentation to support any date of first use prior to August 1990. While written documentation is not an absolute requirement, by the same token, as registrant White Swan itself has noted, "oral testimony is strengthened by corroborative documentary evidence." (Respondent's brief page 7).

Respondent's testimony was taken on September 27, 1995 in the following order: Heidi Rickabaugh; Harold Saltzman; Ruth Saltzman; and Deborah Saltzman. We will review the salient points of these depositions in the foregoing order.

As previously noted, Heidi Rickabaugh is the owner of a graphic design firm which designed projects for then registrant White Swan. When asked how long her firm had done work for White Swan, she replied that "it's probably 1986 or '84, '85." (Rickabaugh deposition page 12). Moreover, when asked when she had designed an earlier trademark label for White Swan, Ms. Rickabaugh stated that "it was probably in the eighties, '80 -- '85." (Rickabaugh deposition page 7). When Ms. Rickabaugh was asked about the circumstances under which she designed the rough strip of paper featuring the words COLOR YOUR GARDEN which White Swan



then purportedly used at the January 1989 New York Gift Show, she not only could not remember the firm that did the typesetting (Rickabaugh deposition page 18), but in addition, she could not remember how much she charged White Swan for designing this rough label, other than to speculate that it was "probably nothing." (Rickabaugh deposition page 14). Moreover, Ms. Rickabaugh acknowledged that she had absolutely no written documentation pertaining to the design of this rough label featuring the words COLOR YOUR GARDEN which White Swan then purportedly used at the January 1989 New York Gift Show. (Rickabaugh deposition page 15).

Turning to the deposition testimony of Mr. Saltzman, we note that he testified that when he wrote his cease and desist letter of October 14, 1992 to petitioner, he stated that he did not personally know when then registrant White Swan first used the trademark COLOR YOUR GARDEN. (Harold Saltzman deposition page 7). According to Mr. Saltzman, in setting the August 1990 first use date in the aforementioned cease and desist letter, he simply relied upon "the date that had been shown in the registration of White Swan for COLOR YOUR GARDEN." (Harold Saltzman deposition page 7). This is a somewhat interesting answer inasmuch as the letter was sent on October 14, 1992, and yet the registration did not issue to White Swan until April 6, 1993. Presumably, Mr. Saltzman was relying upon White Swan's application, and not upon its registration, which, of course, had not issued. Finally, we note that Mr. Saltzman stated that it was not

his responsibility to oversee trademark matters on behalf of White Swan. Rather, these responsibilities were handled by his wife Ruth Saltzman. (Harold Saltzman deposition page 8).

Considering next the deposition testimony of Ruth Saltzman, we note that she too was quite vague as to when White Swan took various actions. For example, prior to any use by White Swan of the mark COLOR YOUR GARDEN, White Swan used the mark PAINT WITH FLOWERS for its flower seeds. When Mrs. Ruth Saltzman, the person at White Swan responsible for trademark matters, was asked when she came up with the name PAINT WITH FLOWERS, she at first said that "it would have been around 1985," but later said that it "was probably earlier than that." (Ruth Saltzman deposition pages 6 and 7). When questioned about the first rough draft "label" bearing the purported mark COLOR YOUR GARDEN, Mrs. Ruth Saltzman was unable to specify the date on which it was created, and moreover, she was unable to identify who actually prepared this very rough draft "label." (Ruth Saltzman deposition page 9). Finally, when questioned about the actual canisters bearing White Swan's mark COLOR YOUR GARDEN, Mrs. Ruth Saltzman was unable to state when these canisters were actually prepared, although she was able to state that they were first "used" in August 1990. (Saltzman deposition page 11). The vagueness characterizing the testimony of Mrs. Saltzman is particularly troubling inasmuch as she is by no means a novice when it comes to

trademark matters. Both she and her husband Harold Saltzman testified that she was responsible for trademark matters for White Swan, and that she had helped in preparing approximately 80 trademark applications on behalf of White Swan. (Ruth Saltzman deposition pages 19 and 20).

Finally we turn to the deposition testimony of Deborah Saltzman, president of White Swan. Deborah Saltzman is the person who, on behalf of White Swan, purportedly traveled to the New York Gift Show held in January 1989. She purportedly displayed at that gift show canisters of flower seeds bearing the mark PAINT WITH FLOWERS. On the tray holding the canisters was allegedly a very rough draft "label" (really a simple strip of paper) having the words COLOR YOUR GARDEN on it. At the outset, we note that Deborah Saltzman was unable to identify even one person not affiliated with White Swan who could attest that White Swan used a rough strip of paper bearing the words COLOR YOUR GARDEN at the January 1989 New York Gift Show (Deborah Saltzman pages 15-16). Moreover, Deborah Saltzman could not identify by name even one other exhibitor at this January 1989 show. (Deborah Saltzman deposition page 15). Furthermore, Deborah Saltzman acknowledged that White Swan had absolutely no documentary evidence whatsoever showing any use of the phrase COLOR YOUR GARDEN at this January 1989 show. Indeed, White Swan has totally failed to provide any documentary evidence showing that it made any use whatsoever of COLOR YOUR GARDEN at either the January 1989 New York Gift Show or

the other 1989 trade shows at which White Swan claims that it displayed the rough label bearing the phrase COLOR YOUR GARDEN (e.g. the Atlanta Gift Show). As was the case with the January 1989 New York Gift Show, White Swan did not identify any individual not affiliated with White Swan who could attest to any use whatsoever by White Swan of the phrase COLOR YOUR GARDEN prior to August 1990. Indeed, White Swan did not even provide documentary evidence of any type whatsoever showing that any of White Swan's employees even attended the January 1989 gift show or the other 1989 gift shows discussed by Deborah Saltzman. Such other documentary evidence could have included, merely by way of example, airline tickets to New York, hotel receipts while in New York, receipts evidencing the rental of space at the New York Gift Show, etc. We note that the New York gift show purportedly took place in January 1989 and that the other few gift shows testified to by Deborah Saltzman purportedly occurred during the remainder of 1989. Mr. Harold Saltzman's cease and desist letter was sent to petitioner on October 14, 1992, just over three years after the January 1989 New York Gift Show. Good business practices would suggest that White Swan would have saved the aforementioned receipts for, at a minimum, the purposes of substantiating tax deductions.

In summary, we find that registrant has simply not established by clear and convincing evidence that it first used the mark COLOR YOUR GARDEN prior to August 1990. As

discussed above, the testimony put on by then registrant White Swan is extremely vague, and is at times inconsistent. Accordingly, we find that priority of use of the mark COLOR YOUR GARDEN for flower seeds rests with petitioner, who first used that mark in March 1990.

Even assuming for the sake of argument that then registrant White Swan did make some use of the phrase COLOR YOUR GARDEN at the January 1989 New York Gift Show and other 1989 trade shows, we find that this use was not trademark use or use analogous to trademark use to establish any rights in COLOR YOUR GARDEN that could be claimed by White Swan. Reproduced below is White Swan exhibit 3, which consists of a photograph of four canisters of flower seeds each of which bears White Swan's mark PAINT WITH FLOWERS. The four canisters are in a tray, and across the tray is a strip of paper bearing in plain block letters the words COLOR YOUR GARDEN. Purportedly, what is shown in White Swan exhibit 3 was displayed at the January 1989 New York Gift Show and a few other gift shows held during the remainder of 1989.



### WHITE SWAN EXHIBIT 3

Heidi Rickabaugh, who purportedly supervised the preparation of this strip of paper bearing the words COLOR YOUR GARDEN, testified that the strip "was a rough," and it was just a "view of a concept." (Rickabaugh deposition pages 8 and 11). Indeed, Ms. Rickabaugh repeatedly stated that Exhibit 3 was "definitely a rough," and that its purpose was "just [to give] an idea if this would work." (Rickabaugh deposition pages 14 and 15).

Mrs. Ruth Saltzman testified that in January 1989, any display of the words COLOR YOUR GARDEN by White Swan was "just a rough concept." (Ruth Saltzman depositions pages 26 and 27). More telling, Mrs. Ruth Saltzman testified that in 1989 White Swan's product "was always being sold as PAINT WITH FLOWERS," and that in using the words COLOR YOUR GARDEN in 1989, White Swan was just "testing the concept." (Ruth Saltzman deposition page 33). Mrs. Ruth Saltzman further confirmed that at these 1989 trade shows there was nothing

to give to customers bearing the words COLOR YOUR GARDEN, and that White Swan did not advertise or promote the purported mark COLOR YOUR GARDEN during that time period because White Swan was promoting instead its marks PAINT WITH FLOWERS and COLOR SCHEME GARDENING. (Ruth Saltzman depositions pages 33 and 34). Finally, Mrs. Ruth Saltzman acknowledged that "the first actual product" bearing the mark COLOR YOUR GARDEN did not come out from White Swan until August 1990. (Ruth Saltzman deposition page 36).

Concluding with the deposition testimony of Deborah Saltzman, who purportedly was at the 1989 trade shows, she acknowledged that White Swan did not "sell any goods that had the label COLOR YOUR GARDEN on them" and that any goods that were shipped from the 1989 trade shows instead bore the mark PAINT WITH FLOWERS. (Deborah Saltzman deposition pages 12 and 13). Moreover, Deborah Saltzman acknowledged that at these 1989 trade shows, White Swan had no signs or advertisements bearing the words COLOR YOUR GARDEN. (Deborah Saltzman deposition page 14).

Even assuming for the sake of argument that White Swan Exhibit 3 did appear at the January 1989 New York Gift Show and other 1989 shows in the manner shown above, we find that based on the totality of circumstances, any potential customers of White Swan who saw the words COLOR YOUR GARDEN on this very crude strip would not view the words COLOR YOUR GARDEN as a source indicator. Stated somewhat differently, we find that even assuming for the sake of argument that

White Swan Exhibit 3 was used at the 1989 trade shows, its use would not constitute trademark use or use analogous to trademark use. As can be seen from Exhibit 3 and as testified to by White Swan's witnesses, the product being sold in 1989 was PAINT WITH FLOWERS. While a product can, of course, have more than one trademark, we find that the use of COLOR YOUR GARDEN in the manner reflected in White Swan Exhibit 3 would not be perceived as a trademark, but rather would be perceived as a declaratory statement to "COLOR YOUR GARDEN" with PAINT WITH FLOWERS flower seeds. White Swan's witnesses have repeatedly referred to the depiction of COLOR YOUR GARDEN in White Swan Exhibit 3 as being a rough draft and as being but a mere test concept. Put quite simply, even if we assume that White Swan actually used the very rough label bearing the words COLOR YOUR GARDEN at the 1989 trade shows, such use was not "of such a nature and extent as to create public identification of the target term [COLOR YOUR GARDEN] with the [registrant's] product." T.A.B. Systems v. PacTel Teletrac, \_\_\_ F.3d \_\_\_, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996). Moreover, even assuming that White Swan made use of COLOR YOUR GARDEN in 1989, and even assuming further that such use would have been perceived by some potential customers as a source identifier, White Swan's employees have been totally unable to indicate the number of potential customers who saw this 1989 use and thus we are unable to discern anything "in the record to indicate whether this group of customers



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constituted more than a negligible portion of the relevant market." PacTel Teletrac, 37 USPQ2d at 1882.

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Decision: The petition to cancel Registration No.  
1,763,148 is granted.

R. F. Cissel

E. W. Hanak

P. T. Hairston  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board